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**MAILED**

**FEB 28 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of :  
KOHNO *et al* :  
U.S. Application No.: 10/585,985 :  
PCT No.: PCT/JP2005/000737 :  
Int. Filing Date: 21 January 2005 :  
Priority Date: 21 January 2004 :  
Attorney Docket No.: 80441(302767) :  
For: PROTEIN IMMOBILIZATION METHOD :  
AND QUANTIFICATION METHOD :

**DECISION**

This is a decision on the petition under 37 CFR 1.78(a)(3) filed 19 October 2010, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed international applications set forth in the amendment filed with the petition.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 37 CFR §§ 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Here, the petition does not satisfy item (1) above. Applicants submitted an amendment that states:

This application is a U.S. national stage application which claims priority under 35 USC §119 and 35 USC §120 to the following two international applications designating the United States: PCT/JP2004/000504, filed on January 21, 2004 the entirety of which is incorporated by reference and

PCT/JP2005/000737, filed on January 21, 2005 the entirety of which is incorporated by reference.

With regard to international application number PCT/JP2005/000737, the present application cannot claim benefit under 35 U.S.C. 120 to this application because both applications have the same filing date. In other words, the present application is merely a different stage of international application PCT/JP2005/000737. See MPEP § 1893.03(c), next to last paragraph.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional or international application designating the U.S. applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional or international application. Here, the amendment does not identify the relationship of international application PCT/JP2004/000504 to the instant application.

Moreover, the reference to add the prior-filed application PCT/JP2004/000504 is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(b).

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet (37 CFR 1.76(a)(5)) or a proper amendment (complying with the provisions of 37 CFR 1.121) to correct the above matters are required. In addition, the improper incorporation by reference statements must be removed.

Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web, by facsimile to the Office of PCT Legal Administration at (571) 273-04559, or if mailed addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Any questions concerning this matter may be directed to James Thomson at (571) 272-3302.

A handwritten signature in black ink, appearing to read "Bryan Lin". The signature is fluid and cursive, with the first name "Bryan" being more prominent than the last name "Lin".

Bryan Lin  
Legal Examiner  
Office of PCT Legal Administration